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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,586	04/01/2004	Chris W. Cicenas	09086.0037-00	5862
22852	7590	09/11/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER WUJCIAK, ALFRED J	
			ART UNIT 3632	PAPER NUMBER
			MAIL DATE 09/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,586

Applicant(s)

CICENAS ET AL.

Examiner

Alfred Joseph Wujciak III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 80 and 82-127 is/are pending in the application.
- 4a) Of the above claim(s) 128-131 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 97, 105, 106, 112 and 115-127 is/are allowed.
- 6) ☒ Claim(s) 80, 82-96, 98-104, 107-111, 113 and 114 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

This is the final Office action for the serial number 10/814,586, METHODS AND APPARATUSES FOR ASSEMBLING RAILINGS, filed on 4/1/04.

Election/Restrictions

Newly submitted claims 128-131 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 80, 82-127, drawn to subcombination, classified in class 256, subclass 59.
- II. Claims 128-131, drawn to combination, classified in class 256, subclass 65.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because rail can be fastened to the post by L-shaped bracket with mounting holes. The subcombination has separate utility such as providing ornament appearance of rail by covering both edges thereof.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104.

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See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 128-131 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

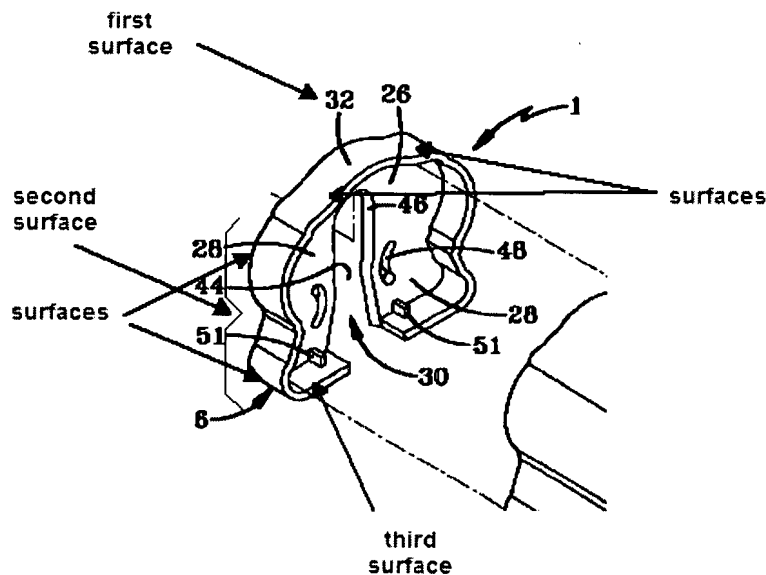
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 80, 82, 84-96, 98-99, 100-104, 107-111 and 113-114 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent # 5,788,224 to Platt in view of US Patent Application Publication # 2005/0127346 to Steffes.

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Platt teaches a rail assembly comprising a rail (2), a post (3) and a bracket (1) for mounting the rail to the post. The bracket comprises a post surface (28) at least a portion of which is configured to abut a mounting surface of the post, at least two surfaces (32 and on the side adjacent to element 32) configured to be associated with and not parallel to the post surface of the bracket. A first surface (32) of the at least two surfaces is configured to accommodate the rail mounted to the post in a first configuration and a second surface (on the side adjacent to element 32) of the at least two surfaces is configured to accommodate the rail mounted to the post in a second configuration different from the first configuration. The first configuration of the rail is configured to be mounted to the post at a first angle relative to the mounting surface of the post and in the second configuration of the rail is configured to be mounted at a second angle relative to the mounting surface of the post different from the first angle. Both of the first configuration and the second configuration of the rail is configured to be in a substantially horizontal orientation. The first surface comprises at least two first surfaces (two surfaces are inclined from the top of element 32). The second surface comprises at least two second surfaces. The assembly further comprises the third surface (located on the bottom of the bracket) configured to be associated with the post surface. Wherein in the first configuration of the rail relative to the post, a longitudinal axis of the rail is at a first angle relative to the mounting surface of the post, and in the second configuration of the rail relative to the post, the longitudinal axis of the rail is at a second angle relative to the mounting surface of the post different from the first angle. The rail is in physical contact with both of the at least two surfaces. The rail is not in physical contact with one of the at least two surfaces (outer surface of

1st or 2nd surface of bracket). The endmost surface of the rail is substantially parallel to the mounting surface. See drawing of figure 2 from Platt's invention shown below for clarification:



Platt teaches the rail but fails to teach the horizontal width of the rail is greater than horizontal width of the bracket. Steffes teaches the rail (60 and 20) having horizontal width greater than the horizontal width of the bracket (40). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified Platt's width of rail greater than width of bracket as taught by Steffes to provide alternative method for mounting rail on the bracket.

Platt teaches the first surface and second surface but fails to teach the first surface forms about a 45 degrees angle with the post surface and second surface forms about a 45 degrees angle with the post surface and first surface. Furthermore, Platt teaches the third surface but fails to teach the third surface forms about a 45 degrees angle with both the first and second surfaces.

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It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the angle of first surface, second surface and third surface to 45 degree to provide designer's preference for improving of the railing assembly.

In regards to claim 107, Platt teaches the rail but fails to teach the rail having a substantially U-shaped cross-sectional configuration. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the shape of cross-sectional configuration to U-shaped to reduce the weight in rail.

In regards to claim 111, Platt teaches the first and second angles but fails to specify the first angle is at 90 and second angle is at 45 degrees. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have modified the angle of first and second surfaces to 90 and 45 degrees to provide designer's preference for the appearance of the bracket.

Claim 83 is rejected under 35 U.S.C. 103(a) as being unpatentable over Platt '224 in view of Steffes and in further view of US Patent # 6,698,726 to Platt.

Platt '224 teaches the rail is configured to be mounted to the post at an angle relative to a longitudinal axis of the post but fails to teach the rail is not in the substantially horizontal orientation. Platt '726 teaches the rail (16) mounted to the post at an angle and not in the substantially horizontal orientation. It would have been obvious for one of ordinary skill in the art at the time the invention was made to have replaced Platt '224 rail assembly with Platt'726 rail assembly to provide convenience for mounting rail at an angle that is not in horizontal orientation.

Allowable Subject Matter

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Claims 97, 105-106, 112 and 116-127 are allowed.

Response to Arguments

Applicant's arguments with respect to claims 80, 82-96, 98-104, 107-111 and 113-114 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Joseph Wujciak III whose telephone number is (571) 272-6827. The examiner can normally be reached on 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571) 272-6815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alfred Joseph Wujciak III
Primary Examiner
Art Unit 3632

9/5/07



A. JOSEPH WUJCIAK III
PRIMARY EXAMINER
TECHNOLOGY CENTER